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Ron Cada

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Patent
Attorney's Docket No. 033053-025

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)

Mark A. Gallop, et al.)

Group Art Unit: 1616

Application No.: 09/972,425)

Examiner: Badio, Barbara P.

Filed: October 5, 2001)

Confirmation No.: 5701

For: BILE-ACID DERIVED COMPOUNDS)
FOR PROVIDING SUSTAINED)
SYSTEMIC CONCENTRATIONS OF)
DRUGS AFTER ORAL)
ADMINISTRATION)

Assistant Commissioner for Patents
Washington, D.C. 20231

AMENDMENT/REPLY TRANSMITTAL LETTER

Sir:

Enclosed is a reply for the above-identified patent application.

☒ A Petition for Extension of Time is also enclosed.

☐ A Terminal Disclaimer and a check for ☐ \$55.00 (2814) ☐ \$110.00 (1814) to cover the requisite Government fee are also enclosed.

☐ Also enclosed is _____

☐ Small entity status is hereby claimed.

☐ Applicant(s) request continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$375.00 (2801) ☐ \$750.00 (1801) fee due under 37 C.F.R. § 1.17(e).

☐ Applicant(s) previously submitted __, on __, for which continued examination is requested.

- ☐ Applicant(s) request suspension of action by the Office until at least __, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (146/246) is also enclosed.
- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below:
- ☐ An Extension of Time Fee in the amount of \$110.00 is enclosed.
- ☐ Charge \$_____ to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: March 17, 2003

By:


Julie L. Henrich
Registration No. 48,070

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Ron Cada

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Patent

Attorney's Docket No. 033053-025

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Patent Application of:

Kenneth C. Cundy, et al.

Serial No.: 09/972,425

Filed: October 5, 2001

For: BILE-ACID DERIVED
COMPOUNDS FOR PROVIDING
SUSTAINED SYSTEMIC
CONCENTRATIONS OF DRUGS
AFTER ORAL ADMINISTRATION)

) Group Art Unit: 1616

) Examiner: Badio, Barbara P.

) Confirmation No.: 5701

*HA
Badio
3-29-03*

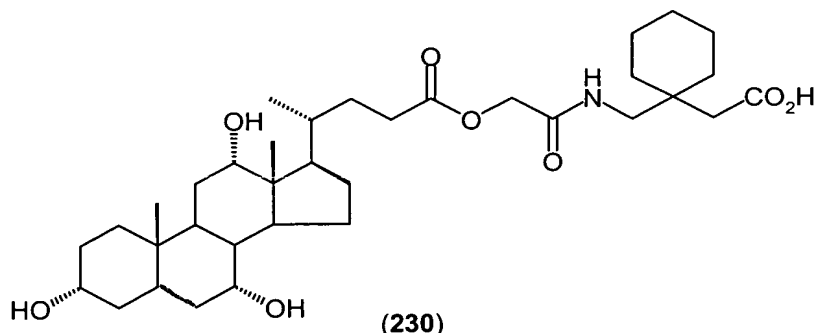
Assistant Commissioner for Patents
Washington, D.C. 20231

ELECTION OF SPECIES

Sir:

This Election is responsive to the Office Action issued January 15, 2003. The Office Action, in the form of an election of species, set forth a one month period of time to reply. Also included herewith is a petition for a month extension of time. Accordingly, this Election is being submitted on or before its current due date of March 17, 2003 (March 15, 2003 falling on a Saturday).

Applicants hereby elect the species identified by compound 230, as shown below, for the purposes of searching only.



Applicants believe that claims 1-10, 19 and 20 read on this elected species. In light of the statement within the Office Action that "...a generic concept will be identified if possible, by the examiner as the inventive group for examination", the Examiner is reminded of *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) in which the court articulated the general proposition that:

[A]n applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. *Id.* at 331. (Emphasis in original).

As such, Applicants would like to reserve the right to traverse any subsequent divisions made by the Examiner of the present invention into "inventive groups".

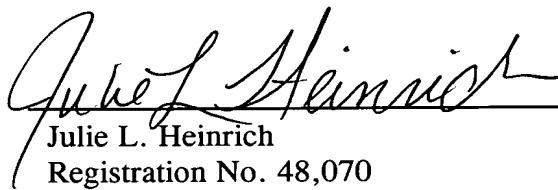
Application Serial No. 09/972,425
Attorney's Docket No. 033053-025

Early examination on the merits is requested. If the Examiner has any questions concerning this election, the Examiner is invited to contact the undersigned so as to expedite prosecution.

Respectfully submitted,
BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: March 17, 2003

By:


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Registration No. 48,070

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